UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,871	02/02/2006	Hiroshi Mukaihara	45010005211	2222

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _02 July 2009_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _9-15_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _9-15_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

The Examiner acknowledges the applicant's submission of the amendment dated 6/2/2009. At this point claims 9, 11, and 13 have been amended and no claims have been added or cancelled. Thus, claims 9-15 are pending in the instant application.

The instant application having Application No. 10/566,871 has a total of 7 claims pending in the application, there are 3 independent claims and 5 dependent claims, all of which are ready for examination by the examiner.

REJECTIONS BASED ON PRIOR ART

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle (US 2001/0041021) in view of Parulski et al (5,633,678).

Regarding Claim 9, Boyle teaches a memory device of a portable type comprising: a terminal capable of being connected to an interface mounted on a host machine and capable of data input/output from/to said host machine (I/O device 122, connected to host machine 110 via connection 130), and a storage element for storing data which include: at least one of image data and audio data (note how JPEG images are stored in computer memory 220 in paragraph 0032), reproduction program data for

said host machine to reproduce at least one of said image data and audio data (see

reproduction program description in paragraph 0032, also note the storage element can

store the reproduction program and transfer it to the host, see paragraph 0010 and how

the imaging conduit that contains the reproduction program is installed on the PC

without the need for user interaction, i.e., when the storage element is first connected to

the host), and execution program data for said host machine to execute said

reproduction program using said reproduction program data (inherently present, since

the host machine executes the reproduction program as described in paragraph 0032)

and a writing program to write at least one of said image data and audio data from said

host machine to said storage element in response to a detection signal that said host

machine detects a connection of said terminal to said interface (the sync manager runs

after the device is connected, as described in paragraph 0010, also see the description

of the write program that uploads data from a personal computer 110 to the handheld

electronic device 124, paragraph 0036).

However, Boyle does not teach at least one of the image and audio data to be

reproduced is selected via the host machine by a user, the selected data being not

changed by a user.

Parulski et al (US 5,633,678) teaches a media device holding pictures, which,

when connected to a host computer, a user can select from the host device which

categories of pictures the user wishes to transfer from the camera to the host (left half of

Figure 4 and Column 6 Line 60 to Column 7 Line 7). It would have been obvious to

person having ordinary skill in the art at the time the invention was made to which the

subject matter pertains to have allowed a user to select images via the host machine to determine which images are transferred to the host system (as in Parulski) in the device of Boyle, since the user may not want all the images on the portable device in the host device.

Regarding Clam 10, Boyle and Parulski teach a portable memory device as described in Claim 9, wherein the host machine can activate said execution program in response to said detection signal to read and reproduce at least one of said image data and audio data stored in said memory element (the sync manager runs after the device is connected, as described in paragraph 0010, also see the description of uploading data from a personal computer to the handheld electronic device, paragraph 0036), when said host machine previously stores at least said reproduction program data and execution program data (imaging conduit 310 of the sync manager, installed on the host, paragraph 0010), and when said terminal is connected to said interface in the state that said storage element stores at least one of said image data and audio data (see Figure 6 and particularly steps 614, 618, and 620, where if the storage element stores an image and is connected, the imaging conduit that contains the reproduction program is run).

Regarding Claim 11, Boyle teaches a recording medium for storing a computer-executable program, the program having program code comprising:

a detecting step of detecting detection signal indicating that a terminal of a portable memory device is connected to said interface (see how the sync manager runs

after the device is connected, as well as an additional description in paragraph 0010

how the device runs without any need for user interaction); and

an executing step of executing a program in a reproduction program data for

reproducing at least one of image data and audio data stored in said memory device, in

response to said detection signal (see description of how the imaging conduit

reproduces the image data in paragraph 0032, also note that the host executes this

program, and thus an executing step is inherently present); and

a writing step to write at least one of said image data and audio data from a host

machine to said storage element (see description of writing the data from a personal

computer to the handheld electronic device, paragraph 0036),

However, Boyle does not teach at least one of the image and audio data to be

reproduced is selected via the host machine by a user, the selected data being not

changed by a user.

Parulski et al (US 5,633,678) teaches a media device holding pictures, which,

when connected to a host computer, a user can select from the host device which

categories of pictures the user wishes to transfer from the camera to the host (left half of

Figure 4 and Column 6 Line 60 to Column 7 Line 7). It would have been obvious to

person having ordinary skill in the art at the time the invention was made to which the

subject matter pertains to have allowed a user to select images via the host machine to

determine which images are transferred to the host system (as in Parulski) in the device

of Boyle, since the user may not want all the images on the portable device in the host

device.

Regarding Claim 13, Boyle teaches a data processing system comprising:

a host machine having an interface capable of data input/output (computing

device 110), and a portable memory device comprising a terminal capable of being

connected to said interface (paragraph 0020), and a storage element for storing at least

one of image data and audio data (paragraph 0019), reproduction program data for said

host machine to reproduce at least one of said image data and audio data (see

reproduction program description in paragraph 0032, also note the storage element can

store the reproduction program and transfer it to the host, see paragraph 0010 and how

the imaging conduit that contains the reproduction program is installed on the PC

without the need for user interaction, i.e., when the storage element is first connected to

the host), execution program data for said host machine to execute a program in said

reproduction program data in response to a detection signal that said host machine

detects a connection of said terminal to said interface (see how the sync manager runs

after the device is connected, as well as an additional description in paragraph 0010

how the device runs 'without any need for user interaction), and a writing program to

write at least one of said image data and audio data from said host machine to said

storage element (see description of writing data from a personal computer to the

handheld electronic device, paragraph 0036),

wherein at least one of the image data and audio data to be reproduced is

selected by a user ("the sync manager also provides the user the capability to change

the data on one device…and subsequently synchronize the changed data with data located on the computing device", Paragraph 0024 in Boyle).

However, Boyle does not teach at least one of the image and audio data to be reproduced is selected via the host machine by a user, the selected data being not changed by a user.

Parulski et al (US 5,633,678) teaches a media device holding pictures, which, when connected to a host computer, a user can select from the host device which categories of pictures the user wishes to transfer from the camera to the host (left half of Figure 4 and Column 6 Line 60 to Column 7 Line 7). It would have been obvious to person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have allowed a user to select images via the host machine to determine which images are transferred to the host system (as in Parulski) in the device of Boyle, since the user may not want all the images on the portable device in the host device.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle and Parulski in view of AppleCare Document: 122014.

Regarding Claim 12, Boyle and Parulski teach all limitations of Claim 11 as described above, wherein the program has code comprising

an outputting step of outputting at least one of said image data and audio data to said portable memory device (see description of outputting data from a personal computer to the handheld electronic device, paragraph 0036 in Boyle).

However, while Boyle mentions that images and 'other such data' (paragraph

0008) may be transferred across to the portable media device (also see paragraph 0036

where image data is downloaded to the portable device from a host device), he does

not give an example of what this 'other data' may be. Apple's iPod, however, enables

users to download software from Apple that is transferred from a host machine to the

iPod portable memory device automatically once it is connected to the host machine

(see first paragraph of AppleCare Document: 122014). It would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which the

subject matter pertains to add a controlling step of controlling to output said image

reproduction and execution data onto the host computer and to transfer this program to

the handheld device during the outputting step just as the iPod Updater has a

controlling step of controlling to output audio reproduction and execution data. The

motivation for this is that it keeps software programs flexible, and any minor bug in a

program on a handheld device would be able to fixed by uploading to the handheld

device a new version of software from the host (see AppleCare Document: 122014 for a

list of bug fixes in the iPod software, for example).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle

and Parulski in view of Kahn (US 2004/0004737).

Regarding Claim 14, Boyle and Parulski teach all limitations of Claim 13 as

addressed above. Boyle clearly has a network (218 in Boyle) in his system, but does

not explain what data could be transferred over the network. Kahn teaches a network

over which images are shared, including an external apparatus (image server 331-333

in Kahn). It would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which the subject matter pertains that Kahn's network

could be the network in Boyle. In this combination, when a device (such as handheld

device 110) is connected to a host machine (such as 120 in Boyle) a program (such as

the program specified in Kahn that begins at 522 in Figure 5, also see paragraph 0082)

is run that uploads images to the external apparatus. The motivation for this comes

from Kahn, who states that his network provides the benefits of automatic organization

and easy sharing among friends (paragraph 0089 in Kahn).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle

and Parulski in view of Sesek (US 2003/0076365).

Regarding Claim 15, Boyle and Parulski teach all limitations of Claim 9 as

addressed above. Boyle teaches a memory device of a portable type that can store

images as well as programs for exchanging these images, but does not teach displaying

these images as icons or as a reduced image of a file. However, Sesek teaches a

technique that displays reduced images, or "thumbnails" of each image that can be

displayed by a host machine (see paragraphs 0008-0011 in Sesek). It would have been

obvious at the time the invention was made to a person having ordinary skill in the art to

which the subject matter pertains to integrate this display system into the writing

program that writes selected files to a portable memory device (such as that described

in paragraph 0036 of Boyle). Motivation for this comes from Sesek, who states that

thumbnails 'are useful for indicating the contents of a page or image' (paragraph 0007 in

Sesek) and also that they allow the user 'to easily select pages or images for viewing'

(paragraph 0006 in Sesek). Thus, by integrating Sesek's technique into the write

program, additional benefits are obtained.

ARGUMENTS CONCERNING PRIOR ART REJECTIONS

Rejections - USC 102/103

Applicant's arguments with respect to Claims 9, 11, and 13 have been fully

considered but are moot in view of the new grounds of rejection.

ARGUMENTS CONCERNING NON-PRIOR ART REJECTIONS/OBJECTIONS

Rejections - USC 112

Applicant's arguments/amendments with respect to claims 9, 11, and 13 have

been considered and have overcome the Examiner's prior rejections and thus are

withdrawn.

CLOSING COMMENTS

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the

application as recommended by **M.P.E.P. ' 707.07(i)**:

CLAIMS REJECTED IN THE APPLICATION

Per the instant office action, claims 9-15 have received a second action on the

merits and are subject of a second action final.

DIRECTION OF FUTURE CORRESPONDENCES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Anthony Giardino whose telephone number is (571) 270-3565 and can normally be reached on Monday - Thursday 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Sanjiv Shah can be reached on (571) 272 - 4098. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.A. Giardino   /Stephen Elmore/
                                                 Primary Examiner, Art Unit 2185
/M.G./

Patent Examiner
Art Unit 2185

September 17, 2009